

Remarks

This is a full and timely response to the outstanding nonfinal Office Action mailed **February 1, 2006**.

Prior to entry of this Amendment, claims 1-27 remained pending in the present application. Upon entry of the amendments in this response, claims 11, 13-18, and 24-27 remain pending in the present response. More specifically, claim 11 is directly amended and claims 1-10, 12 and 19-23 are canceled without prejudice, waiver or disclaimer. It is believed that the foregoing amendments add no new matter to the present application.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Rejections under 35 USC § 101

Claims 11 and 24 stand rejected under 35 USC § 101.

With respect to the 101 rejection, the Office Action, in part, states: "Claims 11 and 24 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter." Office Action, Page 2.

Applicant's respectfully disagree that claims 11 and 24 are directed to non-statutory subject matter. The MPEP at 2106 IV.B.1(a) States:

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Claims 11, taken as a whole, is directed to a server and not a mere program listing. Accordingly, this claim is clearly statutory under the MPEP and the 101 rejection of these claims should be withdrawn.

Claim 24, taken as a whole, is directed to a printer and not a mere program listing. Accordingly, claim 24 is also clearly statutory under the MPEP and the 101 rejection of claim 24 should be withdrawn.

Rejections under 35 USC § 102

Claims 1-27 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nozawa (U.S. Patent Number 6,781,709)

MPEP 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

102 rejection of Claims 11

Independent 11, as amended, states (emphasis added):

A server, comprising:

(a) means for receiving a request from a client;

(b) means for responding to the request by transmitting a program of computer readable instructions to the client, the program for enabling the client to:

i) use a specific printer having a plurality of output trays to print a document; and

ii) display an indicator that indicates the identity of an output tray
from the plurality of output trays that receives the document;
wherein the server is the printer.

Claim 11 has been amended to include the limitations of 12. Examiner's combined rationale for rejecting claim 11 and 12 is therefore considered in the following discussion.

It is respectfully submitted that the 102 rejection of claim 11 should be withdrawn for at least the reason that Nozawa does not disclose at least the claim features that are highlighted in claim 11 above.

With respect to amended claim 11, the Examiner appears to take the position that Nozawa discloses a printer that can provide a client with a program to clients that enables the client to both use the printer to print a document and to display the identity of the output tray that prints the document.

Based upon the rationale provided by the Office Action, for rejecting claim 12, the Examiner appears to take the position that Nozawa discloses such a printer at column 8, line 14 to column 9, line 48.

It is respectfully submitted that this is incorrect. This particular section cited by the Examiner discusses, in part, a Print Driver that is "recorded in advance in the floppy disk 22". See Nozawa at column 8, line 29-31. There is no indication that the print driver is obtained from a printer.

Moreover, nowhere does Nozawa disclose a printer that can serve the claim 11 program to a client.

Thus, Nozawa does not anticipate claims 11 and the rejection should be withdrawn.

102 rejection of dependent Claims 13-18

If independent claim 11 is not disclosed by Nozawa then its dependent claims 13-18 are also not disclosed because each of these claims contains all features/elements/steps of independent claim 11. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Thus, Nozawa does not anticipate claims 13-18, and the rejection should be withdrawn.

102 rejection of claim 24

Independent 24 states:

24. A printer having a plurality of output trays, comprising:
apparatus for responding to a request received from a client by transmitting a program of computer readable instructions to the client, the program for enabling the client to:

- i) use the printer to print a document; and
- ii) display an indicator that indicates an output tray from the plurality of output trays that receives the document.

It is respectfully submitted that the 102 rejection of claim 24 should be withdrawn for at least the reason that nowhere does Nozawa disclose a printer that can transmit, to a client, a program for enabling a client to both use the printer to print a document AND to display an indicator that indicates an output tray that receives the document.

Accordingly, Nozawa does not anticipate claim 24, and the rejection should be withdrawn.

102 rejection of claims 25-27

If claim 24 is not disclosed by Nozawa then dependent claims 25-27 are also not disclosed at least because these claims contain all features/elements/steps of independent claim 24. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Conclusion

Applicants believe that this application is in condition for allowance, in view of the above remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,
Shell S. Simpson et al.

Date

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Hewlett-Packard Company
P.O. Box 272400 M/S 35
Fort Collins CO 80527-2400

By

Matthew L. Wade

Matthew L. Wade
Registration No. 42,206
Telephone: 208 396 5263